

## REMARKS

### **Reconsideration And Allowance Are Respectfully Requested.**

Claims 1-41, 63-72 are currently pending. Claim 52-60 and 62 have been canceled and replaced with new claims 63-72. No other claims have been amended. No new matter has been added. Reconsideration is respectfully requested. The amendment and remarks are not believed to require undue consideration and relate to issues previously discussed during the prosecution of the present application.

Applicant would first like to thank Primary Examiner Passaniti for the courtesies extended during the interview conducted on October 24, 2001. During the course of the interview, the recapture rule was discussed as it relates to the pending application. After discussing the pending claims in detail, Applicant agreed to amend the claims by including limitation to both the “unitary” nature of the insert and the fact that “the insert is short than the tubular section” in an effort to narrow the issues for consideration in the present reissue application.

With this in mind, the Applicant now presents new claims 63-72 which substantial conform to prior claims 52-60 and 62 with the exception that the new claims include limitations to the “unitary” nature of the insert and the fact that “the insert is short than the tubular section”. The only limitation from the allowed patent claims not included in the newly submitted claims relates to the rigid nature of the insert relative to the tubular section.

As such, the only question at issue in the present application appears to be whether Applicant is entitled to broaden the reissue claims by removing reference to the rigid nature of the insert relative to the tubular section, but add additional limitations to the exact position of the insert and the material characteristics of the insert.

Specifically, independent claims 63 and 68 are narrower in many respects than the claims originally considered and as such are not believed to constitute a recapture of subject matter given up during original prosecution of the present application. For example, claims 63 and 68 defines “a tubular section including a first end located at the butt end of the golf club shaft and [a] second end positioned slightly short of the distal end of the golf club shaft”. The original allowed claims make no distinction as to the first end and second end of the tubular section. Presumably, the decision not to include such limitations in the original claims was based upon a desire not to specifically define the position at which the insert must be secured to the shaft; that is, the insert of the originally filed claims could have been secured adjacent the grip or adjacent the club head, while new reissue claims 63 and 68 specifically require that the insert be positioned adjacent the second end of the shaft at a position adjacent the golf club head.

New reissue claims 63 and 68 are further narrower than the originally allowed claims in that they respectively includes limitations related to “the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball” and “the insert being formed from a material controlling the

stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft". This limitation is material to the error which occurred during the prosecution of the original patent application. That is, Applicant failed to appreciate the patentable significance of positioning an insert at the second end of a golf club shaft for achieving vibration absorbance or stiffness control.

Courts have previously considered situations such as the present wherein a reissue claim is broader in some respects and narrower in other respects. In fact, courts have rejected the contention that if a reissue claim is broader in any respect, it necessarily should be deemed broader in all respects and the recapture rule should apply. *Ball Corp. v. United States*, 759 F.2d 1429, 1438, 221 U.S.P.Q. 289, 296. (Fed. Cir. 1984). The Federal Circuit, however, limited its decision to situations where the broader aspect of the claim "is not material to the alleged error supporting reissue". *Id.*

Considering the broadened limitations of reissue claim 52, it becomes clear that these limitations are not material to the error supporting reissue. Specifically, the error supporting reissue relates to Applicant's failure to appreciate the significance of securing a vibration absorbing insert to the second end of a golf club shaft adjacent the club head. The inclusion of an insert which is "more rigid" than the tubular section is irrelevant to the alleged error supporting reissue and the recapture rule should not be applied as specified by the Federal

Court in *Ball Corp.* Regardless of whether the broadened limitations relating to reissue claims 63 and 68 are material, the U.S. Claims Court, in evaluating *Ball Corp.*, determined "that the

recapture rule should not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when, as is potentially the case here, the reissue claim is narrower than the canceled claim in a way that is material to the “error”“. *Patecell v. United States*, 16 Cl.Ct. 644, 652, 12 U.S.P.Q. 2d 1440 (Cl.Ct. 1989). The Court in *Patecell* based their decision on the fact that the crucial issue in assessing the significance of narrowing claim limitations on the existence of an error in a reissue application is the intent of the applicant when he or she amended the claim in a narrowing manner. *Ball Corp.*, 729 F.2d at 1436, 221 U.S.P.Q. at 295. However, the Court in *Patecell* reasoned that

“when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee’s intent [that is, whether the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable] and, hence, as to the absence of ‘error’ cannot be made based exclusively on a comparison of the reissue claim with the canceled claim. Under the patent laws, the fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrow in some respect necessarily also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim being patentable ... Therefore one cannot presume merely from the act of canceling a claim that a patent applicant made a deliberate judgment that a second claim that is narrower in a certain respect than the canceled claim also would be

unpatentable....The conclusion should not change when a second claim, while narrower in at least one respect, is also broader in some respect. The applicant may have agreed with the patent examiner that some original claim was unpatentable but may not have considered, when canceling the claim, that the claim could have been rendered patentable by the addition of a particular limitation. Hence, a deliberate decision to cancel a particular claim because it is unpatentable would not necessarily constitute a deliberate judgment that a claim that is broader in some ways and narrower in others also would be unpatentable.”

*Patecell*, 16 Cl.Ct. 644 at 653.

The Court in *Patecell* describes exactly what happened in the present situation. Specifically, the originally filed claims were amended in an effort to overcome rejections based upon prior art. However, Applicant did not appreciate the significance of the insert position as it may relate to a vibration absorbing element or stiffness control element in the golf club shaft. The fact that Applicant amended the original claims in an effort to overcome prior art should, therefore, have no bearing on whether the narrower reissue claims would have similarly been addressed by the Applicant.

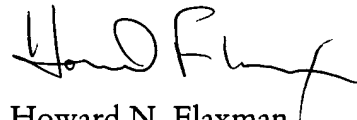
It is, therefore, Applicant’s opinion that the recapture rule does not apply to claims 63-72 and Applicant respectfully requests that the rejection thereof be withdrawn.

Further, and with reference to the filing of a supplemental oath or declaration, Applicant respectfully requests that the filing be held in abeyance until a final determination is made as to the allowable nature of claims 63-72.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made".

Applicant respectfully requests consideration of the preceding remarks and entry of this amendment. If the Examiner believes an interview would be helpful in expediting the prosecution of the present application, he is urged to contact the undersigned at (703) 920-1122.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard N. Flaxman", with a stylized flourish at the end.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Cancel claims 52-62.

Add new claims 63-72 as follows:

63. A golf club shaft having a distal end and butt end, comprising:  
a tubular section including a first end located at the butt end of the golf club shaft and a  
second end positioned slightly short of the distal end of the golf club shaft;  
an unitary insert secured to the second end of the tubular section, the insert being shorter  
than the tubular section, the insert extends from the second end of the tubular section to the distal  
end of the golf club shaft and includes a tubular first end securely coupled to the second end of  
the first member and a tubular second end shaped and dimensioned for secure attachment within  
a hosel of a golf club head;  
the insert being formed from a vibration absorbing material which absorbs undesirable  
vibrations resulting from an individual striking a golf ball.
64. The golf club shaft according to claim 63, wherein the tubular section is made from a  
material chosen from the group consisting of steel, graphite and fiberglass.
65. The golf club shaft according to claim 63, wherein the insert is made from a lexan or  
fiberglass composite.

66. The golf club shaft according to claim 63, wherein the insert is made from titanium.

67. The golf club shaft according to claim 63, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length.

68. A golf club shaft having a distal end and butt end, comprising:

a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft;

a unitary, semi-rigid insert secured to the second end of the tubular section, the insert being shorter than the tubular section, the insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the first member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head;

the insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft.

69. The golf club shaft according to claim 68, wherein the tubular section is made from a material chosen from the group consisting of steel, graphite and fiberglass.



70. The golf club shaft according to claim 68, wherein the insert is made from a lexan or fiberglass composite.

71. The golf club shaft according to claim 68, wherein the insert is made from titanium.

72. The golf club shaft according to claim 68, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length.